

REMARKS/ARGUMENTS

Claims 1-11, 13 and 14 stand rejected. In the present Amendment, claim 1 has been amended and new claims 15-22 have been added. It is respectfully submitted that no new matter has been introduced into the present application by the amendments to claim 1 or the addition of the new claims. Reconsideration of the present application is respectfully requested in view of the following remarks.

The rejection of claims 1, 3-11 and 13-14 under 35 U.S.C. 102(a) as being anticipated by Parra Rapado et al. (WO 03/16308) is respectfully traversed. However, in order to expedite the prosecution of the present patent application, applicants are submitting herewith a certified translation of the priority document for the present patent application (i.e., DE 102 34 875.8 filed in Germany on July 25, 2002). It is respectfully submitted that the submission of the certified translation of the priority document establishes that the presently claimed invention is entitled to an effective filing date of July 25, 2002. Accordingly, since the WO 03/16308 document is not a reference to the present application, this rejection should be withdrawn.

The rejection of claims 1-11 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Hofman et al. (WO 03/022843) is respectfully traversed. However, in order to expedite the prosecution of the present patent application, applicants are submitting herewith a certified translation of the priority document for the present patent application (i.e., DE 102 34 875.8 filed in Germany on July 25, 2002). It is respectfully submitted that the submission of the certified translation of the priority document establishes that the presently claimed invention is entitled to an effective filing date of July 25, 2002. Accordingly, since the WO 03/022843 document is not a reference to the present application, this rejection should be withdrawn.

The rejection of claims 1-11 and 13-14 under 35 U.S.C. 103(a) as being unpatentable over Maier et al. (EP 1 101 764) is respectfully traversed for the reasons set forth below.

The Examiner has acknowledged that the claimed compounds are not disclosed in Maier et al. It is the Examiner's position that the Maier et al. compounds are structurally analogous to the compounds of the present claims and that the primary difference is that the -CF₃ group on

the pyrazolyl ring in the compounds of the present invention is at a different position from that of the compounds of the Maier et al. patent. Therefore, according to the Examiner, the compounds of the present invention are positional isomers of the reference compounds and it would have been obvious to one having ordinary skill in the art to prepare the instantly claimed compounds because they are positional isomers of the reference compounds. It is respectfully submitted that the Examiner's position, at best, is an argument that it would have been obvious to try the positional isomers of the Maier et al. reference. However, "obvious to try" is not the standard for prima facie obviousness. There is no teaching whatsoever in the Maier et al. reference that would motivate one of ordinary skill in this art to make the modifications to the compounds of formula (I) that would be necessary to produce any of the compounds of the present invention. The Maier et al. reference does not teach that it is possible or desirable to move the trifluoromethyl group on the pyrazolyl ring to other positions on that ring. Instead, even in the broad Formula (I), the position of the trifluoromethyl group is fixed, which indicates that it is important that the trifluoromethyl group be in that position only. The properties of herbicidal compounds are not predictable and even slight changes in structure can lead to substantial changes in the properties of the compound. Accordingly, since: (1) the Maier et al. reference does not contain any teachings that would motivate one of ordinary skill in this art to make the structural changes necessary to produce the compounds of the present invention; and (2) the effects of any change in the structure of herbicidal compounds (especially complex organic compounds) is unpredictable and thus cannot lead to an expectation that the modified compound would have equivalent properties to the reference compound; it is respectfully submitted that the compounds of the present claims are not obvious in view of the compounds of the Maier et al. reference.

The provisional rejection of claims 1-11 and 13-14 under the judicially created doctrine of obviousness-type double patenting over claims 1-12 and 14-15 of copending application no. 10/627,256 is respectfully traversed. However, solely in order to expedite the prosecution of the present patent application, a Terminal Disclaimer over this copending application is enclosed herewith.

The provisional rejection of claims 1-11 and 13-14 under the judicially created doctrine of obviousness-type double patenting over claims 1-5 and 10-12 of copending application no.

10/487,549 is respectfully traversed. The cited patent application, 10/487,549, is not commonly owned with the present application.

The provisional rejection of claims 1, 3-11 and 13-14 under the judicially created doctrine of obviousness-type double patenting over claims 1-5 and 9-11 of copending application no. 10/486,398 is respectfully traversed. The cited patent application, 10/486,398, is not commonly owned with the present application.

In view of the above, it is respectfully submitted that each of the presently pending claims in this application is in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider the present application and issue a Notice of Allowance for pending claims 1-11 and 13-22.

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Respectfully submitted,

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Enclosures: Terminal Disclaimer
Certified Translation of German Priority Document